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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,049	01/18/2001	Gavin Brebner	B-4084 618514-1	7680

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EXAMINER

TIV, BACKHEAN

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,049

Applicant(s)

BREBNER, GAVIN

Examiner

Backhean Tiv

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Detailed Action

Claims 1-11 are pending in this application.

Information Disclosure Statement

The information disclosure statement filed Paper No. 5 has been considered.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

Before the first claim, there should be an expression to the effect of "What is claimed :".

Claims 1, 2, 9 are objected to because of the following informalities:

As per claim 1 and 9, there is a comma after computer, the comma should be a semi-colon.

As per claim 2, it is claimed to be dependant on claim 2, line 1 "process according to claim 2", examiner interprets this to be a mistake and will assume it to be "process according to claim 1" for the purposes of art rejection.

Appropriate correction is required.

Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from any other multiple dependant claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 112

1 The following is a quotation of the second paragraph of 35 U.S.C. 112:

2 The specification shall conclude with one or more claims particularly pointing out and distinctly
3 claiming the subject matter which the applicant regards as his invention.
4

5 Regarding claims 1-11, as per claim 1, 4, and 9, the phrase "(profile.xml)" or/and
6 "(Generic_offers.xml)" renders the claim indefinite because it is unclear whether the
7 limitation(s) in the parentheses are part of the claimed invention. See MPEP
8 § 2173.05(d). Claims 2,3,5-8 are rejected based on its dependency on claim 1. Claims
9 10-11 are rejected based on its dependency on claim 9.

10 ***Claim Rejections - 35 USC § 103***
11

12 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
13 obviousness rejections set forth in this Office action:

14 (a) A patent may not be obtained though the invention is not identically disclosed or described as set
15 forth in section 102 of this title, if the differences between the subject matter sought to be patented and
16 the prior art are such that the subject matter as a whole would have been obvious at the time the
17 invention was made to a person having ordinary skill in the art to which said subject matter pertains.
18 Patentability shall not be negated by the manner in which the invention was made.
19

20
21 Claims 1-3,5,7,9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable
22 over WO 99/16003 issued to Newman in view of US Patent 5,860,071 issued to Ball et
23 al(Ball).
24

25 As per independent claim 1, Newman teaches process for personalized access
26 to information available on the Internet network, characterized in that it involves the
27 steps of:

1 creating at least one profile file comprising private data owned by the user,
2 and/or data regarding the technical specifications of the user's computer(page 2,
3 lines 28-29);
4 in order to receive an offer file comprising matching rules for matching services
5 accessible via the internet to said at least one profile(page 10, lines 7-14);
6 applying the matching rules in the offer file to the profile file in order to select one
7 t s or more services from the offer file(page 5, lines 28-31 and page 6, lines 1-3);
8 generating a HTML page describing said selected services(page 6, lines 3-9);
9 pushing said HTML page into a web browser for permitting direct access to the
10 services selected(page 6, lines 13-17).

11 However Newman does not teach repeatedly polling a service provider.

12 Ball teaches repeatedly polling a service provider(col.5,lines 64-67 and
13 col.6,lines1-23)

14 Therefore, it would have been obvious to one having ordinary skill in the art at
15 the time of the invention to modify the process of Newman to add repeatedly polling a
16 service provider as taught by Ball in order to keep track of changes in a document
17 repository in an efficient manner (col.2,lines 14-15).

18 As per claim 2, process according to claim 1 comprising creating and updating a
19 local file comprising the selected services(Ball, Fig.6,col.6,29-32).

20 As per claim 3, process according to claim 2 characterized in that the polling is
21 executed after a predetermined period, and when the user requests the establishment
22 of an Internet connection(Ball, col.5,lines 64-67 and col.6,lines 1-23).

1 As per claim 5, process according to claim 1 characterized in that said at least
2 one profile file comprises private data regarding the user and technical data relating to
3 the user's computer(Newman, page10, lines 11-14,31 and page 11, lines 1-3); it is
4 inherent that there is technical data relating to the user's computer because
5 advertisements are being sent to inform the users for upgrades.

6 As per claim 7, process according to claim 1 characterized in that it is used for
7 achieving an electronic business application(Newman, page 1, lines 30-31).

8 As per claim 7, process according to claim 2, characterized in that it is used for
9 achieving an electronic business application(Newman, page 1, lines 30-31).

10 As per claim 7, process according to claim 3, characterized in that it is used for
11 achieving an electronic business application(Newman, page 1, lines 30-31).

12 As per claim 7, process according to claim 5, characterized in that it is used for
13 achieving an electronic business application(Newman, page 1, lines 30-31).

14 Claim 9 is of the same scope as claim 1. Claim 1 recites a method while claim 9
15 recites an apparatus, therefore is rejected based on the same rationale (see claim 1
16 rejection).

17 Claim 10 is of the same scope as claim 2. Claim 2 recites a method while claim
18 10 recites an apparatus, therefore is rejected based on the same rationale (see claim 2
19 rejection).

20 Claim 11 is of the same scope as claim 3. Claim 3 recites a method while claim
21 11 recites an apparatus, therefore is rejected based on the same rationale (see claim 3
22 rejection).

1

2 Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over
3 WO 99/16003 issued to Newman in view of US Patent 5,860,071 issued to Ball et
4 al(Ball) in further view of US Patent 5,710,884 issued to Dedrick.

5

6 Newman in view of Ball teaches all the limitations of claim 1, however does not
7 teach as per claim 4, process according to claim 1 characterized in that said profile file
8 is encrypted into said local user machine.

9 Dedrick teaches characterized in that said profile file is encrypted into said local
10 user machine(col.6,lines 22-27).

11 Therefore, it would have been obvious to one having ordinary skill in the art at
12 the time of the invention to modify the process of Newman in view of Ball to add
13 characterized in that said profile file is encrypted into said local user machine as taught
14 by Dedrick in order to protect the user profile from anyone other than the individual who
15 is associated with the information (col.6,lines 24-25).

16 As per claim 7, process according to claim 4 characterized in that it is used for
17 achieving an electronic business application(Newman, page 1, lines 30-31).

18

19 Claims 6 and 7are rejected under 35 U.S.C. 103(a) as being unpatentable over
20 WO 99/16003 issued to Newman in view of US Patent 5,860,071 issued to Ball et
21 al(Ball) in further view of US Patent 6,035,339 issued to Agraharam et al. (Agraharam).

22

Newman in view of Ball teaches all the limitations of claim 1 however does not teach as per claim 6, process according to claim 1 characterized in that said at least one profile comprises technical data that is automatically collected by means of an analysis software program.

Agraharam teaches characterized in that said at least one profile comprises technical data that is automatically collected by means of an analysis software program(col.4,lines 14-17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Newman in view of Ball to add characterized in that said at least one profile comprises technical data that is automatically collected by means of an analysis software program as taught by Agraharam in order to more conveniently determine the user terminal capabilities(col.1,lines31-35).

As per claim 7, process according to claim 6 characterized in that it is used for achieving an electronic business application(Newman, page 1, lines 30-31).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,141,010 issued to Hoyle, Abstract, col.1-6

US Patent 5,784,564 issued to Camaisa et al., Abstract, col.1-3

US Patent 5,572,643 issued to Judson, Abstract, col.1-3

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1 US Patent 6,477,565 issued to Daswani et al., Abstract, col.1-4

2 US Patent 5,933,811 issued to Angles et al., Abstract, col.1-4

3

4 Any inquiry concerning this communication or earlier communications from the
5 examiner should be directed to Backhean Tiv whose telephone number is (703) 305-
6 8879. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M.
7 Monday-Friday.

8 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
9 supervisor, Glenton B Burgess can be reached on (703) 305-4792. The fax phone
10 number for the organization where this application or proceeding is assigned is 703-
11 872-9306.

12 Information regarding the status of an application may be obtained from the
13 Patent Application Information Retrieval (PAIR) system. Status information for
14 published applications may be obtained from either Private PAIR or Public PAIR.
15 Status information for unpublished applications is available through Private PAIR only.
16 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
17 you have questions on access to the Private PAIR system, contact the Electronic
18 Business Center (EBC) at 866-217-9197 (toll-free).

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3/4/04

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